

REMARKS

Claims 1-6 are pending in the application. Applicant amends claims 1, 5, and 6. No new matter has been added. Support for the amendments to independent claims 1, 5, and 6 can be found at least in the originally-filed specification at page 6, lines 3-7. The Office Action rejected claims 1-6 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application Publication No. 2002/0007311 ("Iseki") in view of U.S. Patent No. 5,655,053 ("Renie").¹

Applicant respectfully traverses the rejections of claims 1-6 under 35 U.S.C. § 103(a).

I. Rejection of Claims 1-6 under 35 U.S.C. § 103(a)

Applicant respectfully withdrawal of the rejections of claims 1-6 under 35 U.S.C. § 103(a) because Iseki and Renie, whether viewed alone or in combination, fail to disclose or suggest every feature of pending claims 1-6.

Amended independent claim 1 recites, in part, a mobile recording medium "manufactured specifically for a place by a company for creating an original electronic album of the place," the mobile recording medium comprising "a program which, when executed by a processor, causes a system to . . . combine pre-recorded material information selected by the user with the information captured by the user to create the

¹ The Office Action quotes 35 U.S.C. § 103(a), but states that claims 1-6 are "rejected under 35 U.S.C. 102(b) as being anticipated by Iseki . . . in view of Renie." Because a proper rejection under Section 102 must be limited to a single reference, *see* M.P.E.P. 2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." citing *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987)), Applicant treats the language "102(b)" as a typographical error.

electronic album of the place comprising both the pre-recorded material information and the information captured by the user."

Iseki does not teach or suggest at least the above-quoted subject matter of amended independent claim 1. The Office Action states that "[i]n response to applicant's argument that Iseki fails to teach a *mobile recording medium manufactured specifically for a place by a company for creating an original electronic album of the place*,..., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." Office Action at 14. Applicant respectfully reiterates that there is structural difference between the recited "mobile recording medium" and Iseki's system. Indeed, Iseki's system is not a "mobile recording medium," let alone one that is "manufactured specifically for a place by a company." Instead, it is a system including an electronic service site connecting with a plurality of image provider terminals. (Iseki at para. [0035]). Being that these terminals are fixed at various locations, they are not "mobile."

The Office Action additionally alleges that Renie expressly discloses a "mobile recording medium" "since Renie teaches automatically inserting personalized opening video segments into pre-recorded stock footage of rides and attractions as well as other stock material on a tape . . . as well as selling the storage medium in the form of a CD-ROM to the visitor at the place." Applicant again respectfully disagrees. At issue is not whether the final, compiled electronic album is stored on a "mobile electronic medium" but rather that the "mobile recording medium" is "for creating an original electronic album of the place." Rather, in Renie, the stock material appears to be stored at a

production facility where the patron cannot access or select it. Renie nowhere discloses that the stock material is stored on a "mobile recording device" prior to delivery to the patron. In other word, any "mobile recording medium" disclosed in Renie is not "manufactured specifically for a place by a company for creating an original electronic album of the place."

For the reasons outlined above and in the Applicant's previous responses, Iseki and Renie fail to disclose or suggest "a mobile recording medium." Notwithstanding the above, Applicant amends independent claims 1, 5, and 6 without prejudice or disclaimer to further prosecution.

Iseki and Renie additionally fail to disclose or suggest "a program which, when executed by a processor, causes a system to . . . combine pre-recorded material information selected by the user with the information captured by the user to create the electronic album of the place comprising both the pre-recorded material information and the information captured by the user" as recited by amended independent claim 1.

Iseki discloses that "the image information registered with an image provider can be watched, printed out or down-loaded by retrieving it under the desired retrieving conditions" *Id.* at [0089]. Similarly, Iseki discloses that a "user who wants to obtain the scenery of a certain place in a certain season and to use such scenery can get such image through the retrieval based on such place" *Id.* at [100]. Iseki, however, discloses at most a search and download service at a stationary terminal that is searchable for images. While the user can browse and download or print images, Iseki does not disclose or suggest that the program "combine[s] pre-recorded material information selected by the user with the information captured by the user to create the

electronic album of the place comprising both the pre-recorded material information and the information captured by the user," as recited in amended independent claim 1. At most, Iseki discloses and suggests that a user can search images and print or download them from a remote storage (i.e. the digital album provider terminal (web site) 3 as shown in Figure 1). Amended independent claim 1 is therefore allowable over Iseki because Iseki fails to disclose or suggest at least the above-quoted subject matter of amended independent claim 1.

As explained previously, Renie discloses a "personalized video system for acquiring video of an individual consumer as shot at an amusement park or the like and combining those images with standard, preshot video of rides or attractions." See Renie at Abstract. Specifically, Renie discloses that

The controller retrieves the personalized footage and automatically assembles the composite tape in accordance with the order in which the sequences are arranged on the standard tape. Since a standard tape is used as a basis, there are no dropouts or blank spaces on the tape reserved for the personalized segments should a person skip a ride. Rather, the personalized segments are copied over or on top of existing stock footage of that particular ride. If a patron skips a ride, his tape will still be complete, as there simply will not be any personalized footage seen on that particular ride.

Id. at 8:7-15. In other words, Renie prepares pre-selected video and provides it to the user without user selection. This is made clear in that "[i]f a patron skips a ride, his tape will still be complete, as there simply will not be any personalized footage seen on that particular ride." In other words, the patron does not select which stock footage to receive. Therefore, Renie fails to disclose or suggest the above-quoted subject matter of amended independent claim 1.

For at least the reasons outlined above, amended independent claim 1 should be allowable over Iseki and Renie. Claims 2- 4 depend from amended independent claim 1 and should therefore allowable at least by virtue of their dependence. Amended independent claims 5 and 6, although different in scope than claim 1, should be allowable over Iseki and Renie for at least reasons as set forth with respect to claim 1. Accordingly, Applicant respectfully requests the withdrawal of the rejections of claims 1-6 under 35 U.S.C. § 103(a).

II. Conclusion

For at least the reasons set forth above, Applicant respectfully requests reconsideration of this application, withdrawal of the rejections, and timely allowance of pending claims 1-6.

The Office Action contains characterizations and assertions regarding the claims and the cited art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant respectfully declines to automatically subscribe to any characterizations or assertions included in the Office Action.

The preceding remarks are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other additional bases of patentability.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney.

Please grant any extensions of time required to enter this Reply and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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